

ESTTA Tracking number: **ESTTA569306**

Filing date: **11/06/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Tricots Saint James
Granted to Date of previous extension	11/06/2013
Address	Zone Industrielle SAINT-JAMES, 50240 FRANCE

Attorney information	Justin R. Young Dineff Trademark Law Limited 160 North Wacker Drive Chicago, IL 60606 UNITED STATES jyoung@dineff.com Phone:3123381000
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Applicant Information

Application No	78656504	Publication date	07/09/2013
Opposition Filing Date	11/06/2013	Opposition Period Ends	11/06/2013
Applicant	Kim, Yunja P.O. Box 3208 Palos Verdes Peninsula, CA 90274 USX		

Goods/Services Affected by Opposition


Class 025. First Use: 1996/04/15 First Use In Commerce: 1996/04/15
All goods and services in the class are opposed, namely: Clothing, namely, denim jeans, pants, sweaters, coats, jackets, dresses, blouses, shirts, shorts, cardigans and skirts

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2361110	Application Date	11/17/1997
Registration Date	06/27/2000	Foreign Priority Date	NONE
Word Mark	SAINT JAMES		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1970/07/03 First Use In Commerce: 1988/00/00 Articles of clothing, namely jackets, cardigans, dresses, skirts, slacks, sweaters, sweat-shirts, shirts, tee-shirts, blouses, overblouses, jumpers, long underpants, pedal pushers, Bermuda shorts, caps, scarves, socks, gloves

Attachments	75390937#TMSN.gif(bytes) Opposition against 78656504 - 11-6-13 new.pdf(147436 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/JustinRYoung/
Name	Justin R. Young
Date	11/06/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. **78/656504**
For the mark **JAMES**
Published in the "Official Gazette" of **July 9, 2013**

Tricot Saint-James))	
))	
))	
v.))	Opposition No.
))	
Kim, Yunja))	
))	
Applicant,))	
))	

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

NOTICE OF OPPOSITION

Tricot Saint-James, ("Opposer"), a joint stock company organized under the laws of France, having its principal place of business at Zone Industrielle, Saint-James, 50240, France, believes that it will be damaged by the registration of the mark "JAMES", shown in Serial Number 78/656504 in International Class 25, and hereby oppose same in accordance with 15 U.S.C. § 1063 and 37 C.F.R. § 2.101.

As grounds for the opposition, Opposer alleges as follows:

1. Commencing long prior to Applicant's filing date and prior to any priority date that can be alleged by Applicant, Opposer has used, and Opposer is now using, the mark "SAINT JAMES" in connection with the sale, advertising and promotion of various goods, including in particular clothing such as jackets, cardigans, dresses, skirts, slacks, sweaters, sweat-shirts, t-shirts, blouses, overblouses,

jumpers, long underpants, pedal pushers, Bermuda shorts, caps, scarves, socks, gloves, among others, covered under International Class 25, distributed and sold by Opposer in commerce.

2. Opposer is owner of, and will rely herein, upon the Federal Registration No. 2,361,110 for the mark “SAINT JAMES” granted in International Class 25. This registered mark is valid, subsisting, and provide *prima facie* evidence of Opposer’s ownership of its mark “SAINT JAMES”, of the validity of said mark, and of Opposer’s exclusive right to use the mark in commerce for the goods specified in said registrations. See Exhibit “A”.

3. Opposer has extensive common law rights in the mark “SAINT JAMES” in connection with various goods, including clothing articles covered under International Classes 25.

4. Since the initial adoption and use of Opposer’s mark “SAINT JAMES” Opposer has engaged in extensive advertising and generated significant sales of its goods under said mark.

5. By virtue of the aforesaid extensive use, advertising, sale and promotion, consumers have come to recognize and associate Opposer’s mark “SAINT JAMES” with Opposer and its goods and services. As a result, Opposer has acquired substantial and valuable goodwill in the mark “SAINT JAMES” and the mark has become a distinctive indicator of the origin of Opposer’s goods long prior to the filing date of the opposed application, and prior to any priority date that can be alleged by Applicant.

6. Notwithstanding Opposer’s prior established rights in the marks “SAINT JAMES,” Applicant has filed Application No. 78656504 with the United States Patent and Trademark Office on July 23, 2012 for “*clothing, namely, denim jeans, pants, sweaters, coats, jackets, dresses, blouses, shirts, shorts, cardigans and skirts*” in International Class 25, as evidenced by the publication of said mark in the *Official Gazette* of the July 9, 2013 issue.

7. Applicant’s application to register the mark “JAMES” is without Opposer’s consent or permission.

8. There is no issue as to priority. The filing date of Applicant’s mark and any priority date that could be alleged by Applicant are subsequent to the first use date of Opposer’s mark “SAINT

JAMES,” and subsequent to the introduction and use of Opposer’s mark “SAINT JAMES” to the marketplace and the purchasing public.

9. The mark “JAMES” that Applicant seeks to register so closely resembles Opposer’s mark “SAINT JAMES” in appearance, sound, and meaning that the use and registration thereof is likely to create the same overall impression on consumers and to cause confusion, mistake, and deception as to the source or origin of Applicant’s services and will injure and damage Opposer and the goodwill and reputation symbolized by its mark “SAINT JAMES.”

10. Applicant’s goods are identical or so closely related to Opposer’s goods that the public is likely to be confused, to be deceived, and to assume erroneously that Applicant’s goods are those of Opposer, or that Applicant is in some way connected or affiliated with, or sponsored by Opposer, all to Opposer’s irreparable damage.

11. Likelihood of confusion in this case is enhanced by the fact that consumers associate the mark “SAINT JAMES” with goods sold, approved, or endorsed by Opposer; furthermore, purchasers of Applicant’s goods are prospective purchasers of Opposer’s goods, and vice-versa.

12. Applicant’s mark “JAMES” will be marketed and sold to the same consumers and through the same trade channels than Opposer’s “SAINT JAMES” mark, therefore, is likely to cause confusion or mistake, or to deceive, within the meaning of Section §2(d) of the Trademark Act.

13. Applicant’s mark “JAMES” so closely resembles Opposer’s “SAINT JAMES” mark that it is deceptive in that it falsely suggests a connection with or approval by Opposer, in violation of Section §2(a) of the Trademark Act. Indeed, Applicant’s mark points uniquely to Opposer, and purchasers will assume that clothing offered under Applicant’s alleged mark are connected with or approved by Opposer.

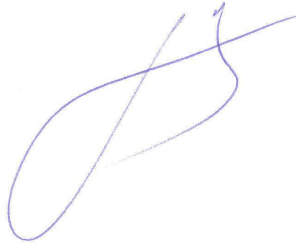
14. If Applicant is permitted to use and register its mark for the goods covered by the opposed application, confusion resulting in damage and injury to Opposer will likely occur.

15. If Applicant were granted the registration herein opposed it would thereby obtain at least a *prima facie* exclusive right to its mark and the use thereof. Such registration will be a source of damage and injury to Opposer.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that Application Serial No. 78/656504 be refused, and for such other and further relief as the Commissioner of Patents and Trademarks shall deem proper and required by the Principles of Equity and Good Conscience.

Trictos Saint-James

By and through their attorney



Dated: November 6, 2013

Justin R. Young
DINEFF TRADEMARK LAW LIMITED
160 N. Wacker
Chicago, Illinois 60606
Phone (312) 338-1000
Facsimile (312) 338-1500
jyoung@dineff.com

EXHIBIT

“A”

Side - 1



**NOTICE OF ACCEPTANCE OF §8
DECLARATION AND §9 RENEWAL
MAILING DATE: Jul 7, 2010**

The declaration and renewal application filed in connection with the registration identified below meets the requirements of Sections 8 and 9 of the Trademark Act, 15 U.S.C. §§1058 and 1059. The declaration is accepted and renewal is granted. The registration remains in force.

For further information about this notice, visit our website at: <http://www.uspto.gov>. To review information regarding the referenced registration, go to <http://tarr.uspto.gov>.

REG NUMBER: 2361110
MARK: SAINT JAMES AND DESIGN
OWNER: TRICOTS SAINT-JAMES

Side - 2

UNITED STATES PATENT AND TRADEMARK OFFICE
COMMISSIONER FOR TRADEMARKS
P.O. BOX 1451
ALEXANDRIA, VA 22313-1451

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Mark Lebow
YOUNG & THOMPSON
209 Madison Street
Suite 500
Alexandria, VA 22314



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

REGISTRATION NO: 2361110 SERIAL NO: 75/390937 MAILING DATE: 09/02/2005
REGISTRATION DATE: 06/27/2000
MARK: SAINT JAMES AND DESIGN
REGISTRATION OWNER: TRICOTS SAINT-JAMES

CORRESPONDENCE ADDRESS:

Robert F. Zielinski, Esq.
Wolf, Block, Schorr and Solis-Cohen LLP
22nd Floor
1650 Arch Street
Philadelphia PA 19103

NOTICE OF ACCEPTANCE

15 U.S.C. Sec. 1058(a)(1)

THE COMBINED AFFIDAVIT FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

NOTICE OF ACKNOWLEDGEMENT

15 U.S.C. Sec. 1065

THE AFFIDAVIT FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 15 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1065.

ACCORDINGLY, THE SECTION 15 AFFIDAVIT IS ACKNOWLEDGED.

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):
025.

CONLEY, JOYCE MARIE
PARALEGAL SPECIALIST
POST-REGISTRATION DIVISION
571-272-9500

**PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION
CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION**
ORIGINAL

REQUIREMENTS FOR MAINTAINING A FEDERAL TRADEMARK REGISTRATION

I) SECTION 8: AFFIDAVIT OF CONTINUED USE

The registration shall remain in force for 10 years, except that the registration shall be canceled for failure to file an Affidavit of Continued Use under Section 8 of the Trademark Act, 15 U.S.C. Sec. 1058, at the end of each successive 10-year period following the date of registration.

Failure to file the Section 8 Affidavit will result in the cancellation of the registration.

II) SECTION 9: APPLICATION FOR RENEWAL

The registration shall remain in force for 10 years, subject to the provisions of Section 8, except that the registration shall expire for failure to file an Application for Renewal under Section 9 of the Trademark Act, 15 U.S.C. Sec. 1059, at the end of each successive 10-year period following the date of registration.

Failure to file the Application for Renewal will result in the expiration of the registration.

NO FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS WILL BE SENT TO THE REGISTRANT BY THE PATENT AND TRADEMARK OFFICE. IT IS RECOMMENDED THAT THE REGISTRANT CONTACT THE PATENT AND TRADEMARK OFFICE APPROXIMATELY ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.

Int. Cl.: 25

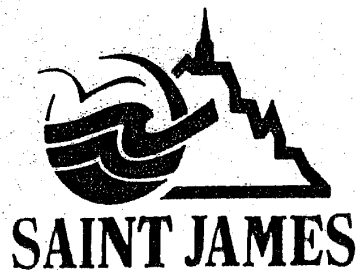
Prior U.S. Cls.: 22 and 39

Reg. No. 2,361,110

United States Patent and Trademark Office

Registered June 27, 2000

**TRADEMARK
PRINCIPAL REGISTER**



TRICOTS SAINT-JAMES (FRANCE JOINT STOCK
COMPANY)
ZONE INDUSTRIELLE
50240 SAINT-JAMES, FRANCE

DERPANTS, PEDAL PUSHERS, BERMUDA SHORTS,
CAPS, SCARVES, SOCKS, GLOVES, IN CLASS 25
(U.S. CLS. 22 AND 39).

FIRST USE 7-3-1970; IN COMMERCE 0-0-1988.

FOR: ARTICLES OF CLOTHING, NAMELY JACK-
ETS, CARDIGANS, DRESSES, SKIRTS, SLACKS,
SWEATERS, SWEAT-SHIRTS, SHIRTS, TEE-SHIRTS,
BLOUSES, OVERBLOUSES, JUMPERS, LONG UN-

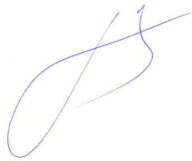
SER. NO. 75-390,937, FILED 11-17-1997.

DAN VAVONESE, EXAMINING ATTORNEY

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing NOTICE OF OPPOSITION was served on this date November 6, 2013 upon Applicant's Attorney correspondence address of record by First-Class mail, postage prepaid, as follows:

Darren S. Cahr
Drinker Biddle & Reath LLP
191 N. Wacker Drive
Suite 3700
Chicago, IL 60606



Justin R. Young